

Amendments to the Drawings:

The attached sheets of drawings include changes to Page 1 and Page 2 with changes to Fig. 1A and Figs. 2 and 3. In Fig. 1A the drain pipe 34 is drawn as L-shaped consistent with Fig. 3 and numerals have been added. In Figs. 2 and 3, numerals have been added.

Attachment: Replacement Sheet Page 1 of 2
 Replacement Sheet Page 2 of 2
 Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Claims 1 through 2 and 4 are pending in the present application. Replacement drawings received on June 27, 2005, were disapproved because of informalities. A new set of drawings providing formalized numbering has been provided and applicant respectfully asks for approval of the attached drawings.

The drawings are objected to under 37 CFR § 1.83(a) as not showing every feature of the invention specified in the claims. First the Examiner asserts that the drawings do not show "a drain pipe having an inverted L-shape" as called for by claim 1. Applicant directs the Examiner's attention to Fig. 3 that shows a drain pipe 34 with an inverted L-shape having a horizontal leg 37A and a vertical leg 37B. Fig. 1A has been amended to specifically show this embodiment of the invention in all of the Figures. Thus Applicant asserts that the figures do show a drain pipe having an inverted L-shape and respectfully requests the drawing objection be withdrawn.

Additionally the drawing amendment to 1A has proper antecedent basis in the original disclosure. Applicant may rely not only on the specification and drawings as filed but also on the original claims if their content justifies it. See MPEP 608.04 (Citing MPEP § 608.01). Upon review of the original claim 1, the claim requires a drain pipe having an inverted L-shape. Thus the original specification contemplated a drain pipe with an inverted L-shape that was shown in original Fig. 3. Therefore the amendment to Fig. 1A has not presented new matter.

The Examiner has also asserted that the drawings do not show "drain pipe.....including a horizontal leg extending into and through the overflow part of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system".

Once again, Fig. 3 shows the inverted L-shaped drain pipe with a horizontal leg 37A and a vertical leg 37B. Furthermore, Fig. 1A has been amended to show the embodiment of Fig. 3 wherein the drain pipe has an inverted L-shape wherein the horizontal leg extends through the overflow port and the vertical leg extends downwardly for connection to a fluid drain system.

Additionally, a numeral has been added to represent the fluid drain system. Once again in establishing a disclosure, Applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. MPEP 608.04 (Citing MPEP § 608.01). The original claim states "said drain pipe having an inverted L-shape, including a horizontal leg extending into and through the overflow part of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system". Additionally, Fig. 3 shows the inverted L-shaped pipe and Fig. 1A shows an embodiment wherein a drain pipe has a vertical leg that extends downwardly for connection with the fluid drain system and has a horizontal leg that extends into and through an overflow port. Thus this amendment to the drawing is not considered to add new matter and only shows the embodiment of Fig. 3 of the invention.

Consequently, the drawing objection is considered overcome.

The drawings have also been objected to as not showing "a fluid drain system". As discussed above, a numeral has been added to Fig. 1A showing the fluid drain system that was provided in the drawings of the original application. The specification has also been amended to call for the fluid drain system as described in the original claims. Thus, the drawing objection is considered overcome.

The next drawing objection asserted by the Examiner is that the drawings do not show "a pipe having a first exposed end and

a second end in communication with a fluid source, wherein the first end comprises a threaded portion" as called for by claim 2. Claim 2 has been amended to require a drain pipe having a first exposed end having an externally threaded portion. First this amendment does not add new matter because the original claim 2 required a pipe having a first exposed end comprising a threaded portion. See page 5, lines 27-29. Additionally the original disclosure in Figs. 1A and 2 show a drain pipe 34 (as described in the original specification) that has an externally threaded portion 31. Thus no new matter has been added and this amended limitation of claim 2 is properly shown within the drawings. Therefore Applicant considers the drawing objection overcome.

Next the Examiner objects to the drawings because the drawings do not show "a plumbing test system" as called for by claim 2. The preamble of claim 2 has been amended to require an overflow system for a bathtub having an overflow port. Thus the preamble of claim 2 requires an overflow system as the preamble of claim 1 and additionally the preamble of claim 1 requires an overflow system for a bathtub that has an overflow port. Thus because there are no objections to claim 1 as all of the features are provided for in the drawing, the amendment to claim 2 causes this drawing objection to be overcome.

The next drawing objection asserted by the Examiner is that "a pipe having a first exposed and second end in communication with a fluid source, wherein the first end comprises a...threaded portion" is not within the drawings. Applicant has amended claim 2 to eliminate the requirement of a pipe having a second end in communication with a fluid source and as discussed above the drawings properly show a pipe having a first exposed

end wherein the first end comprises a threaded portion. Thus this drawing objection is considered overcome.

The drawings are also objected to as not showing "the cap assembly contains a cap" as called for by claim 2. In the previous office action, the Applicant added a paragraph wherein the paragraph stated: "The cap assembly 52, 66 includes a cap 52 having an opening 56 and a planar end 54, with a sealing member 66 secured to the cap 52 and extending over the opening 56 in the planar end". Thus Applicant amended the specification to point out the cap assembly referred to in original claim 2 is represented by a combination of the cap 52 and the sealing member 66. For further clarification, an amendment has been made to Fig. 2 specifically providing the numeral 61 to the cap 52 and sealing member 66 to clearly provide that this limitation is present within the drawings. Additionally, the previously added paragraph has been amended to provide the numeral 61 therein. Thus Applicant considers the drawing objection overcome.

The Examiner has also objected to the drawings as not showing "a sealing material is composed of a material capable of sealing the first end when the cap is threaded onto the first end". This limitation has been amended to require "the cap threadably mounted on the externally threaded portion of the first end such that the cap is sealed against the overflow port when the cap is threaded onto the first end". This amendment gains its antecedent basis in the specification at page 4, lines 14 through 18 that state "a thin sealing membrane 66 is affixed to the face 54 (Fig. 2) of cap 52 so as to seal the aperture in the cap when it is screwed into the threads 31 so that the cap can be effectively sealed against the port 30". Thus no new matter has been added. Additionally, Fig. 3 shows this sealing

arrangement and therefore the drawing objection is considered overcome.

In response to the Applicant's last amendment, the Examiner objected to the amendment under 35 U.S.C. § 132(a) because it introduced new matter into the disclosure. Applicant respectfully traverses this assertion. As stated above, "in establishing a disclosure, Applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it". See MPEP 608.04 (Citing MPEP § 608.01).

The first added material which the Examiner asserts is not supported in the original disclosure is "a drain pipe 34 adapted to be in communication with said drain port 28 and said overflow port 30". Original claim 1 states "a drain pipe adapted to be in communication with said drain port and said overflow port". Thus, this addition of material cannot be new matter as it is in the original claims of the application and may be relied upon by the Applicant. Thus, no new matter was entered by this amendment.

The next sentence objected to is "drain pipe 34 having an inverted L-shape, including a horizontal leg 37A extending into and through the overflow port 30 of the bathtub 18, and a vertical leg 38B extending downwardly for connection to a fluid drain system 38". Original claim 1 states "said drain pipe having inverted L-shape, including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system". Again, this is identical to the limitation added to the specification and because the original claims may be used in establishing a disclosure, this is not new matter and Applicant considers the objection overcome.

The next limitation is "a flexible sealing membrane 66 secured to the cap". To appease the Examiner the Applicant has amended this paragraph and claim 1 to eliminate the word "flexible". In original claim 1 the last limitation states "with a thin sealing membrane secured to the cap and extending over the opening in the circular planar end". Additionally the original specification also states "a thin sealing membrane 66 is affixed to the face 54 of cap 52". (See page 4, lines 14-18). Thus, the original specification provides for a sealing membrane 66 secured to a cap 52 and no new matter is considered added.

The Examiner objects to adding "a sealing member 66 secured to the cap 52". As argued above, original claim 1 states "with a thin sealing membrane secured to the cap". Because the original claims must be considered in establishing a disclosure, no new matter has been added and the Applicant considers the objection overcome.

The next limitation the Examiner considers to be new matter states "wherein a portion of the cap assembly 52, 66 is composed of a material capable of sealing the first end 37A when the cap 52 is threaded onto the first end 37A". Original claim 2 states "a cap assembly threadably mounted on the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded onto the first end". Again, because the original claims of the disclosure must be considered as the original disclosure, Applicant asserts no new matter was added by placing this sentence into the specification. Therefore, Applicant considers the objection overcome.

The Examiner has requested that Applicant cancel the new matter stated above. As asserted throughout this response,

because this paragraph added by the Applicant is identical to limitations provided in the original claims, the paragraph was properly added and Applicant respectfully requests the Examiner reconsider the request for cancellation of the material. Therefore, Applicant asserts no new matter was added during the last office action and respectfully requests the Examiner withdraw the objection.

Claim 4 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, new claim 4 called for a "temporary closure device for a bathtub". In this claim, the preamble has been amended to provide "an overflow system for a bathtub". Thus the preamble of claim 4 has been amended to be similar to the preambles of claim 1 and amended claim 2 and therefore the 35 U.S.C. § 112 rejection is considered overcome.

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, claim 2 calls for "the sealing material to be composed of material capable of sealing the first end when the cap is threaded onto the first end". Applicant has amended this limitation to require that "the cap threadably mounted on the externally threaded portion of the first end such that the cap is sealed against the overflow port". As argued above, this claim limitation gains antecedent basis from the original disclosure at page 4, lines 14-17 that state "a thin sealing membrane 66 is affixed to the face 54 (Fig. 2) of cap 52 so as to seal the aperture in the cap when it is screwed into threads 31 so that the cap can be effectively sealed against the port 30". Thus, Applicant asserts no new matter has been entered and the 112 rejection is overcome.

Claim 2 has been rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regarded as the invention.

Specifically, claim 2 has been rejected as lacking proper antecedent basis for the limitation "the sealing material" in line 12. Applicant has eliminated this portion of the claim and thus the 112 rejection is considered overcome.

Claim 1 has been rejected under 35 U.S.C. § 102(b) or 103(a) as being unpatentable over Ball. This is the identical rejection as made in the previous office action and Applicant reasserts its previous argument:

Applicant respectfully traverses, as Ball does not teach or suggest all the claim limitations. Specifically, Ball does not have either a "horizontal leg extending into and through the overflow port of the bathtub" or "a cap threadably mounted on an end of the horizontal leg extending through the overflow port" as recited in claim 1. Additionally, claim 1 was earlier rejected in the July 7, 2004 office action in view of Ball and Lewis. In this office action, the examiner acknowledged the failures of Ball noting that "Ball fails to disclose that the horizontal leg of the drain pipe 34 extending through the overflow port 30 and the cap 70 have cooperating threads". Applicant believes the Examiner's July 7, 2004 interpretation of the failures of Ball to be correct, and Ball fails to meet at least these two limitations of claim 1.

Additionally, Ball does not disclose "threads on the horizontal leg extending through the overflow port" as recited in claim 1. In the recent office action the examiner has failed to even address the limitation. However, the Examiner did note that the screws 78 "connect to the tabs 56 and 58". Reference

to Fig. 2 of Ball shows that these tabs 56 and 58 are not located on a "horizontal leg extending through the overflow port" as required by claim 1, and are instead located exterior to the overflow port. Accordingly, Applicant submits claim 1 is novel and not obvious in view of Ball.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Delanoy in view of Lewis. Applicant reasserts that claim 2 is non-obvious in view of these two references and therefore presents its argument from the previous office action:

An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

This obvious rejection asserted by the Examiner is based on a combination of prior art references, e.g. the cap assembly of Delanoy, combined with the external overflow drain of Lewis. To justify this combination the Examiner simply stated "[i]t would have been obvious to one of ordinary skill in the bathtub cap or test plug system art, at the time the invention was made, to substitute for the inner screw mounting of the cap assembly into the pipe of Delanoy, the outer screw mounting of the cap assembly onto the pipe as, for example, taught by Lewis wherein so doing would amount to mere substitution of one screw attachment mechanism for another that would work equally as well in the Delanoy device."

The Examiner further justifies the combination by directing the Applicant's attention to Lewis which "discusses another plumbing bathtub test system (note ¶ 0008) having a cap assembly (constituted by test plug 8) which can be threadably mounted to pipe elbow 20 either via outer screw threads or inner screw threads (note ¶ 0020). Applicant respectfully disagrees. The test plug 8 of Lewis is inserted within elbow 20 such that threaded screw 5 is caused to mate with threaded opening 51 (Fig. 6) and tightened by the application of wing nut 7. (Note ¶ 0027). The interchangeability of threads relates to the capture nut 21 which compressively draws elbow 20 to tub 10 and not to the test plug 8. Thus, Lewis does not suggest the combination as proposed, and rather teaches away from the claimed invention.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the

reference, or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994).

Lewis teaches the use of a test plug 8 for water testing. To create a water-tight seal, as previously discussed, the test plug is screwed down within elbow 40 by mating screw 5 within threaded opening 51 supported within elbow 40 by extruded protrusion 50. Thus, upon reviewing Lewis, one skilled in the art would have been led in a direction where a plug with a centrally located screw is used to secure the plug to the pipe rather than the path the Applicant took.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Lewis which teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand.

In addition, even if there was a suggestion or motivation to combine the references, the combination would not result in the invention as claimed. More specifically, the combination would possibly result in the cap assembly of Delanoy, mounted to external threads of a trap and not the external threaded portion of a drain pipe having a first exposed end through an overflow port as is required by claim 2. The only way to arrive at the claimed invention is to use Applicant's disclosure as a blue print which constitutes impermissible hindsight analysis. Therefore, Applicant respectfully requests that the Examiner's obviousness rejection be withdrawn.

Claims 1, 2 and 4 were rejected under 35 U.S.C. § 103 as being anticipated by Oropallo et al. in view of Delanoy. Applicant respectfully traverses the rejection. Applicant asserts that there is no motivation to combine the Oropallo

reference with Delanoy to arrive at the claimed invention. The cited references fail to suggest any motivation for, or desirability of, the combination espoused by the Examiner. Delanoy et al. discloses the use of a metal plate for pressure testing of a drain pipe prior to the connection to a waste water drain. Delanoy et al. contemplates that only the drain pipe be pressure tested, and once ascertained to be tight, the plate is broken so that the ring may receive the waste water pipe. The structure of Delanoy prohibits testing of the system once fully assembled. This is opposite to the teachings of Oropallo wherein a pressure test cap is placed on an overflow assembly that is already fully assembled to perform testing. Thus there is no motivation to combine the two references to arrive at the claimed invention. Because there is no motivation to combine Oropallo and Delanoy, the obvious rejection is considered overcome. Consequently, Applicant respectfully requests allowance of claims 1, 2 and 4.

Even if there is a motivation to combine the Oropallo and Delanoy references, each and every limitation of the claimed invention would not be taught by the combination. Regarding claim 1 specifically, the combination would not teach "the cap having an open ended circular planar end, with a thin sealing membrane secured to the cap and extending over the opening in the circular planar end". The Oropallo reference does not teach a thin sealing membrane and instead teaches a solid test cap 40 as evidenced by Fig. 13. Delanoy does not cure Oropallo as Delanoy teaches a metal plate that must be broken that extends across the face of a ring. (Lines 56-59). Thus, neither Oropallo nor Delanoy teach a sealing membrane. The advantage of having a sealing membrane is that the membrane may be cut to allow for pressure testing once the overflow assembly is

assembled so that a plumber does not have to keep track of multiple caps as would be the case of the Oropallo reference. Therefore, the present invention is considered an improvement over the prior art.

Similarly, claim 4 requires "a thin sealing membrane affixed to the outer surface to seal the aperture of the cap". As argued above, neither Delanoy or Oropallo teach the use of a sealing membrane and therefore each and every limitation of claim 4 is not met. Thus, Applicant respectfully requests allowance of claims 1, 2 and 4.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



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- JLH/jlk -

**Application No. 10/721,694
Reply to Office Action dated 10/06/05
Annotated Sheet Showing Changes**

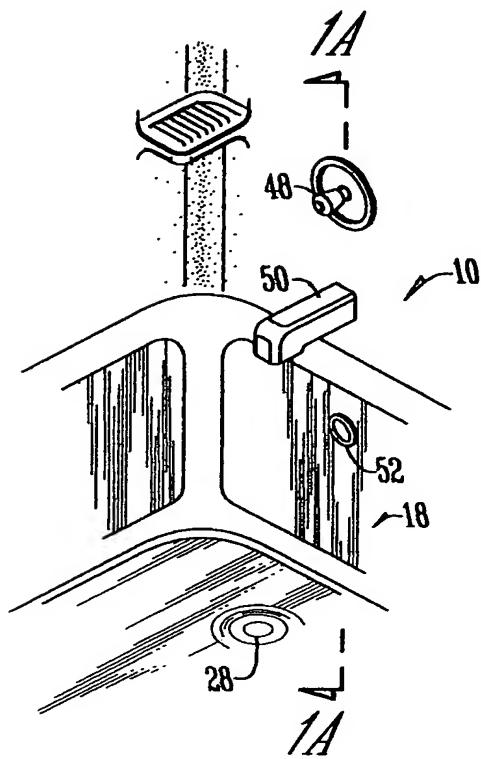


Fig. 1

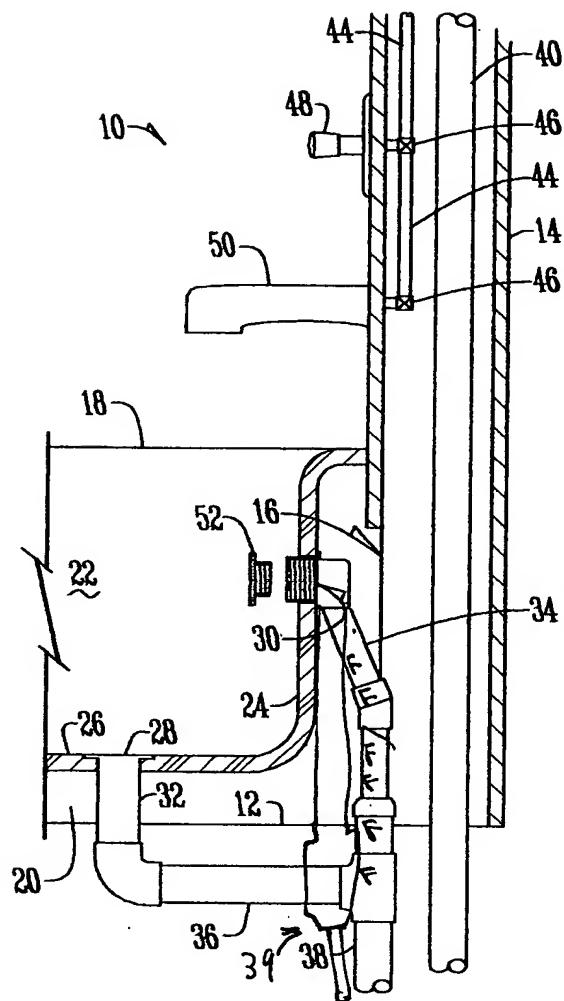


Fig. 1A

Application No. 10/721,694
Reply to Office Action dated 10/06/05
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37B
for AAI-78

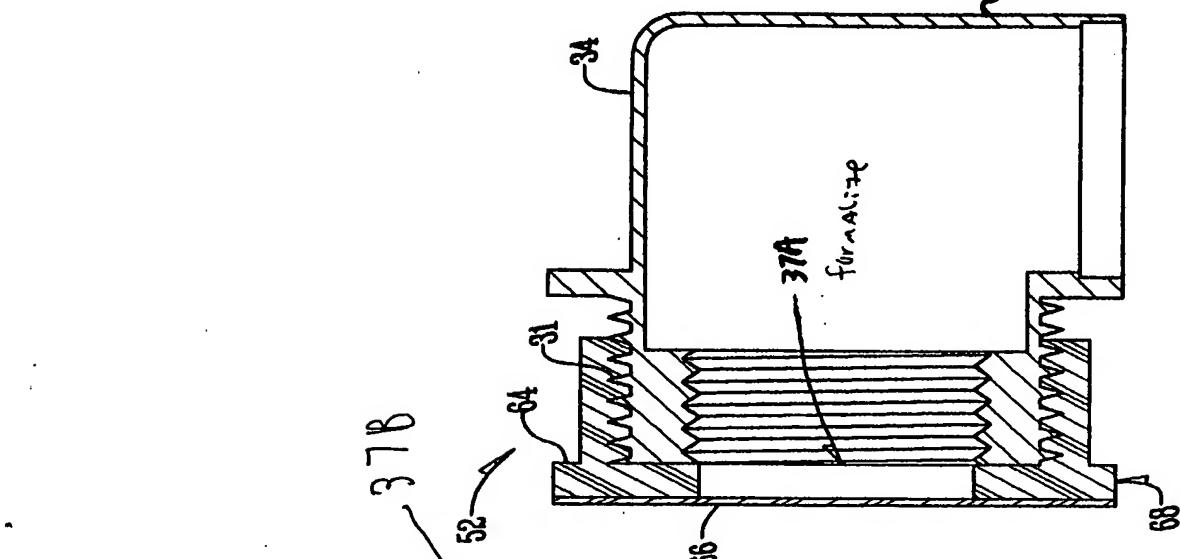


Fig 3

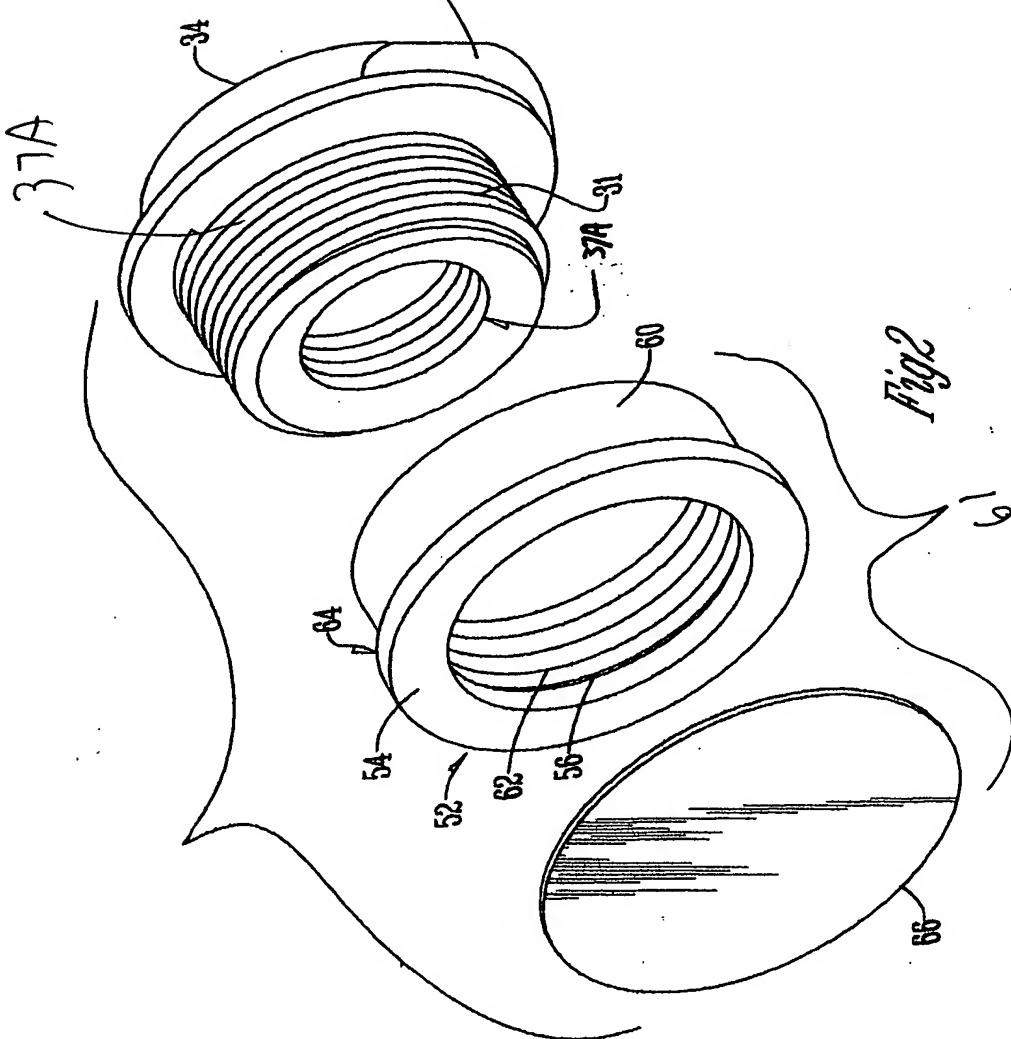


Fig 2